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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,335	08/01/2003	Johnathan P. Tann	13552.4003	3599
34313	7590	12/05/2006	EXAMINER	
ORRICK, HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558				QUELER, ADAM M
ART UNIT		PAPER NUMBER		
		2178		
DATE MAILED: 12/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/632,335	TANN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Adam M. Queler	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 09 November 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-8,11-18,21-25,28 and 29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-8,11-18,21-25,28 and 29 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 01 August 2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## DETAILED ACTION

1. This action is responsive to communications: Amendment and RCE filed 11/09/2006.
2. Claims 1-8, 11-18, and 21-27 are pending in the case. Claims 1 and 11 are independent claims.
3. The rejection of claims 26 and 27 is moot in view of Applicant's cancellation of the claims.

### *Continued Examination Under 37 CFR 1.114*

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/09/2006 has been entered.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-8, and 11-18, and 21-24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohl et al. (US 20020091930A1), and further in view of Applicant's Admitted Prior Art.**

**Regarding independent claim(s) 1 and 11,** Kohl teaches installing a counter on to the device (para. 36). Kohl teaches that the content has been played, or presented (para. 37). Inherently, there must have been a player as this necessary to play content. This player must have been searched for and found as the content was played, whether there is an active search by the OS or merely found by the user. If the content is played (para. 37), the player *must* exist and have been found. , which in order to play the content, must have been searched for and found. As this player was found, or exists, the claim language is met as the premise of the conditional statement in the claims is false. In other words, the entire searching step is anticipated because the player exists. Kohl teaches setting the counter to a specific value, 5, (para. 37), and using it to keep track of the allowable amount of plays (para. 37), though does not explicitly state that it is decrementing the counter. However, since the counter starts at the maximum allowed value, and is a counter recording the number of allowable plays, inherently, the counter must be decremented.

Kohl does not explicitly disclose the counter and content are on removable media. However, Applicant admits that removable media was a popular way get content on devices (p. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use removable media as it was popular to use at the time of the invention and would have increased user acceptance. Inherently, then the counter must have been searched for and installed.

Kohl does not explicitly teach a handheld device, but rather a more general computer. It would have been obvious to one of ordinary skill in the art at the time of the invention to carry out the steps in the order claimed as it has been held the making a device portable is *prima facie*

obvious in the absence of new or unexpected results, *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952).

**Regarding dependent claim(s) 2 and 12**, Kohl teaches multimedia (para. 25)

**Regarding dependent claim(s) 3 and 13**, Kohl teaches audio files (para. 25).

**Regarding dependent claim(s) 4 and 14**, Kohl teaches videos, which comprise at least one graphical image (para. 25).

**Regarding dependent claim(s) 5-8 and 15–18**, as the intended use in different media would not result in a manipulative difference the prior art and the claimed invention(s); the claims are similarly rejected as claims 8 and 13 above. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) and *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962).

**Regarding dependent claim(s) 21 and 23**, Kohl does not explicitly teach all types of media the invention extends too. Keyt teaches that web pages are content that must be protected against illegal use (whole document). Web pages inherently have link to web sites. It would have been obvious to extend Kohl's protection of content to web pages as web pages need to be protected for financial reasons (Keyt, para. 1).

**Regarding dependent claim(s) 22 and 24**, Kohl does not explicitly teach all types of media the invention extends too. Keyt teaches that web pages are content that must be protected against illegal use (whole document). Web pages inherently have link to web sites that are opened in a web browser when clicked. It would have been obvious to extend Kohl's protection of content to web pages as web pages need to be protected for financial reasons (Keyt, para. 1).

**7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kohl and Applicant's Admitted Prior Art as applied to claims 1 and 11 above, and further in view of Headings et al. (US 20020144283A1).**

**Regarding dependent claim(s) 25,** Kohl teaches that when counter expires, the license expires. Kohl does not explicitly disclose deleting the data when the license expires. Headings teaches deleting content when the license expires (para. 28). It would have been obvious to one of ordinary skill in the art at the time of the invention to delete the content in order to comply with various copyrights and distribution rules (Headings, para. 3). Additional motivation is found in the nature of the problem to be solved, which is protecting copyrighted content. Protection of content cannot be any more effective than permanently removing a would-be infringer's possession of the content.

**8. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohl and Applicant's Admitted Prior Art as applied to claims 1 and 11 above, and further in view of Colvin et al. (US 2001/0034712 A1, 10/25/2001).**

**Regarding dependent claim(s) 28 29,** Kohl does not explicitly disclose storing or uploading. Colvin discloses storing the information representing user interaction and uploading it to the server (p. 111). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Colvin with Kohl to provide "quality assurance capabilities" (para. 111).

***Response to Arguments***

**9. Applicant's arguments filed 11/09/2006 have been fully considered but they are not persuasive.**

Applicant's main argument is that the Kohl reference does not recite the searching and installing steps of the independent claims. Kohl teaches the content is played. Applicant has not disputed this. That there must be a player in order to play something is a technical line of reasoning in and of itself that the Applicant has not disputed. Applicant uses the example of a system that does not have an appropriate player. However, as stated above, Kohl does play the content and therefore must have an appropriate player. Whether or not this could happen all the time is not necessary relevant as clearly Kohl's disclosure of playing the content at least proves the appropriate player is present in the normal course of operation of Kohl.

Applicant alleges that Kohl does not teach the circumstance where an appropriate player is not present. However, that by itself is not a claim limitation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Office does not have to consider this case. The limitation reads "installing a content player ... if a content player enabled to present the content rich data does not exist on the handheld device." Logically the limitation has the scope of "either a player enabled to present ... exists on the handheld device or installing a player." Since Kohl plays the content there must be a player installed. If a player is installed then the premise of the installing step is false and the installing step is anticipated.

Applicant's arguments hinge on a circumstance that the player is not installed. However, as explicitly recited in Kohl the content *is* played. This negates Applicant's arguments. At the very least Kohl plays content in the normal course of operation.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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